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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,810	01/29/2002	Mark D. Hanes	MRZ 9038.1	6785

321 7590 10/20/2006

SENNIGER POWERS  
ONE METROPOLITAN SQUARE  
16TH FLOOR  
ST LOUIS, MO 63102

EXAMINER
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RATHINASAMY, PALANI P

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/059,810

Applicant(s)

HANES, MARK D.

Examiner

Palani P. Rathinasamy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) 11,18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/29/2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1/29/2002, 1/29/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

Claim 11 and 18 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. This claim mixes statutory classes and fails the infringement test in MPEP 608.01(n) as being an improper dependant claim. A computer readable medium having instructions to perform the method step would infringe claim 11 and 18, but not the method claim since the computer-readable medium itself only stores steps, it does not necessarily perform them. Mere possession of such a medium would infringe claim 11 and 18, but not the associated method claim.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "first printing program" in claim 1 is used by the claim to mean "creating an electronic version of a motivation package", while the accepted meaning is

"creating a physical copy of a electronic document." The term is indefinite because the specification does not clearly redefine the term.

3. Claim 1 and 9 are rejected to as being unclear. Regarding claim 1, it is unclear to the examiner if the "first printing program" actually involves physical printing of documents or relates to another form of printing. Examiner, after comparing claim to specifications, treats "first printing program" to mean creating an electronic version of a motivation package below. Regarding method claim 9, it is unclear how the participant obtains the motivation package. The fourth paragraph of the claim appears to allow the customer to print the package or allow the participant to print it. However, the third paragraph teaches that the customer prints it and "presents" it to the participant. The plurality of options open for distribution of the motivation package, allow for a customer to print out the motivation package and then somehow transmit it to the participant to print as well. Method claims should be clear steps to performing and should not be ambiguous.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Stoltz et al. (US Pat Pub 2002/0095576) in view of Engel et al. (US 5,907,830).**

**Stoltz et al. teaches of a method for recognizing users by creating certificates that are issued electronically to users [Abstract].**

2. Regarding claims 1, 9, 11-13, 16, 18, and 19-20, applicant teaches of a method where a company selects a motivation package (consisting of a recognition certificate and a award), electronically transmits it to the customer, and the customer prints it out. Stoltz et al. teaches of a method for recognizing users by creating certificates that are issued electronically to customers [Abstract]. After the customer receives the certificate, they are redeemed online for "gift certificates, merchandise, cars, trips or points" [Detailed Description, 0030], [Fig 3]. Stoltz et al. teaches of printing the recognition certificates [Detailed Description, 0034] but does not teach of printing the award after the certificates are redeemed. Stoltz et al. does not teach how the customer redeems the award. Engel et al. teaches of a method where customers connect online to a host, electronically receive coupons, and print the coupons to be redeemed [Summary of the Invention, col 1, lines 24-57]. Therefore, it would have been obvious to one skilled in the art to combine Stoltz et al.'s user recognition system with the printing features of Engel et al.'s electronic coupon distribution system. Regarding claims 9, and 12 applicant teaches that the selection of the motivation package occurs on the Internet. Stoltz et al. teaches that the program is run over the Internet [Detailed Description, 0028-0030] with a server that allows management of the system [Detailed Description, 0031]. Applicant teaches that the motivation package can be printed by the company and physically given to the customer rather than being printed by the customer [claims and specification]. Stoltz et al. similarly teaches that the recognition certificates can

additionally be “physically given” to the user [Detailed Description, 0030]. Regarding claim 12, applicant teaches that the motivation document can include text indicating the “participants name”. Stoltz et al. similarly teaches that the certificates have “the name of the user”, a certificate number and other text on it [Detailed Description, 0048] [FIG 8]. Regarding claim 16 and 17, applicant teaches of “receiving user signals” to determine the motivation package to be displayed and offered. It is clear that Stoltz et al. accomplishes this task with mouse clicks on web links as shown in Figure 9-14 and that is inherent in using any web-based application.

3. Regarding claims 2, applicant teaches that the company can customize the motivation package. Stoltz et al. teaches that the certificates and awards are unique per customer and can be varied according to a number of different variables (such as, number of certificates, type of certificate, award available, etc.) [Detailed Description, 0030].

4. Regarding claims 3, applicant teaches of a company history database that maintains a log of the transactions performed by the company. Stoltz et al. teaches of usage reports that allow the company (“may only be available to executives”) to view details such as redemption statistics, users, etc. [Detailed Description, 0047] that are retrieved from the server database [Detailed Description, 0032].

5. Regarding claim 4, applicant teaches of the motivation package consisting of a motivation document and a motivation award. Stoltz et al. teaches of a certificate [Abstract] and a corresponding award [Detailed Description, 0030].

6. Regarding claim 5, applicant teaches of the motivation document being one of either a certificate of achievement, an acknowledgement of service, or a team accomplishment certificate. Stoltz et al.'s figures 8, 12, and 15 are examples of certificates that are the same as the ones listed by applicant.

7. Regarding claim 6, applicant teaches of the award being a gift certificate. Stoltz et al.'s teaches that the award is a gift certificate [Detailed Description, 0030].

8. Regarding claim 7 and 15, applicant teaches that the printing is done via a "plug-in associated with a web browser." Stoltz et al. teaches of printing the certificates that are displayed on the Internet. Stoltz et al. does not teach how the printing mechanism works. Printing from a web-browser can be achieved by pressing print (file -> print) or by pressing print screen. Additionally, OFFICIAL NOTICE is taken that plug-in application that is loaded inside of a browser have print functions (such as Adobe Acrobat) print through the internal commands of the web-browser (the fundamental print function is inherent in the browser, not the software attachment). Therefore it would have been obvious to print with such a plug in.

9. Regarding claim 8 and 14, applicant teaches that the transmission of the "motivation package" occurs via a network. Stoltz et al. teaches that users access the server via a network [Detailed Description, 0028].

10. Regarding claim 10, applicant teaches of printing the motivation package prior to expiration date. Stoltz et al. teaches of a time period that can be specified for each certificate and if the time period passes, the certificate will be deactivated [Detailed Description, 0030].

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11. Regarding claim 17, applicant teaches of a further step of the customer customizing the motivation package prior to printing. Engel et al. teaches that the coupons that are printed by the customer are "specifically identified" or "personalized" [Summary of the Invention, col 1, lines 40-50]. Engel et al. further teaches that the customer can select the coupons that they want prior to printing [Detailed Description of the preferred embodiments, col 2, lines 20-29], therefore customizing their selection. Therefore, it would have been obvious to one skilled in the art to combine Stoltz et al.'s user recognition system with the customized printing features of Engel et al.'s electronic coupon distribution system.




Any inquiry concerning this communication or earlier communications from the examiner should be directed to Palani P. Rathinasamy whose telephone number is (571) 272-5906. The examiner can normally be reached on M-F 8:30-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PPR



JEFFREY D. CARLSON  
PRIMARY EXAMINER